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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,392	11/12/2003	Kuniya Maruyama	MAKU 8814US	6840
1688	7590	07/11/2005	EXAMINER	
POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,392

Applicant(s)

MARUYAMA, KUNIYA

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment: 18 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 and 6-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

This office action is in response to Applicant's amendment filed 5/18/2005.

Status of Claims

- [1] Claims 1-8 are pending.

Drawings

- [2] The drawing(s) were previously objected for informalities. In view of Applicant's comments submitted on 5/18/2005, all previous objection(s) to the drawings have been withdrawn.

Specification

- [3] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 5/18/2005. Accordingly, the objection(s) to the specification have been withdrawn, and the substitute specification and abstract have been entered.

Claim Rejections - 35 USC § 102

- [4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 1-3, and 6-8 are rejected under 35 U.S.C. 102(b) as clearly anticipated by West, US- 6,062,045, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, West teaches of an item of jewelry comprising a main body (20 in Fig. 2) having an inlay area of concaved shape (72 in Fig. 8, 82 in Fig. 10, and 114 in Fig. 14), and a decorating part secured in said inlay area, wherein said decorating part is composed of a copper alloy which contains 6 to 15 weight percent of copper and 94 to 85 weight percent of gold (from part 5, beginning with line 61, "...have a selected precious metal and/or other material installed in the groove 22...It will, of course, be appreciated that other forms of materials can be inlaid into the groove 22. For example, preformed metal, stone, ceramic, shell or other segments...Preferably, such items will be slightly recessed below the surfaces of the facets ...". Continuing, with part 6, line 32, "...that can be fabricated or forged into appropriate configurations and fit into the mating groove or channel 22. Fluxed or flux free gold or silver

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soldered compounds varying in color and purity between 50% and 99% can be applied on or around desired mating surfaces...” Continuing, with part 7, line 16 “...with the sculpted precious metal part 72 being mounted within a groove 74...) said item of jewelry being secured in said inlay area by a layer of solder in said inlay area between said decorative part and said main body.

(It would also be readily understood and appreciated by those of ordinary skill in the art, of the known aptitude to combine varying percentages of different metals for purposes of obtaining different color schemes, and utilizing the different physical properties of each metal individually as well as the result combined, such as corrosion and hardness characteristics of a jewelry item).

Re: Claim 2, wherein said jewelry has a curved surface at said inlay area (114).

Re: Claim 3, wherein said jewelry is selected from a group of jewelry including rings (Fig. 2), pendants, necklaces, earrings, cuff buttons, brooches, tie tacks, bangles, buckles, chokers, bracelets, watch band and glasses.

Re: Claim 6, wherein said main body is made of a metal chosen from the group consisting of a gold alloy, a silver alloy, a platinum alloy, and combinations thereof (col. 3, paragraph [0027, “and gold or alloys thereof”).

Re: Claim 7, wherein said jewelry includes a flux applied to said main body and/or said decorating part (from col. 3, in paragraph [0033], “Fluxed or flux free gold or silver soldered compounds varying in color and purity between 50% and 99% purity can be applied on or around desired mating surfaces of the hard material”) prior to the insertion of said decorating part in said inlay area and solder (continuing from paragraph [0033], “One way to affix precious metal to the part is to use a brazing process” (to solder (two pieces of metal) together using a

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hard solder with a high melting point) placed about said decorating part at a junction of said decorating part and said main body; said layer of solder being [formed by applying heat to said item of jewelry; whereby, under heat, the flux evaporates forming a gap between said decorating item and said main body and said solder is pulled into said gap to form said layer of solder] (The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976)).

Re: Claim 8, said decorating part being composed of a copper alloy which contains 6 to 15 percent copper and 94 to 85 percent gold (from part 5, beginning with line 61, "...have a selected precious metal and/or other material installed in the groove 22...It will, of course, be appreciated that other forms of materials can be inlaid into the groove 22. For example, preformed metal, stone, ceramic, shell or other segments...); one or both of said decorating parts

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and said inlay area being coated with a flux (from col. 3, in paragraph [0033], "Fluxed or flux free gold or silver soldered compounds varying in color and purity between 50% and 99% purity can be applied on or around desired mating surfaces of the hard material"), such that said flux is positioned between said decorating part and a surface of said inlay area; said item of jewelry being secured in said inlay area by a layer of solder (continuing from paragraph [0033], "One way to affix precious metal to the part is to use a brazing process" (to solder (two pieces of metal) together using a hard solder with a high melting point) which replaces said flux under the influence of heat; said solder securing said decorating part in said main body inlay area.

Response to Arguments

[6] Applicant's arguments filed 5/18/2005 regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive.

To begin, the purpose of an invention of the prior art is irrelevant so long as the structure maintains as being anticipatory. It does not matter that the applicant is solving a different problem since the structure of West emulates that of the applicant. West does indeed either show or disclose each and every feature set forth in the submitted claims. Though West does not exactly teach of the copper alloy, he does, however, state that the decorative part can be a preformed metal, stone, ceramic, shell or other segment. A copper alloy can and is considered a preformed metal or other segment for that matter; not to mention that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength,

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durability, flexibility, hardness, etc. for the application and intended use of that material.

Further, all one would have to do in this case is a substitution of materials, as the structure providing for the submission of each respective material as claimed remains the same.

Applicant continues that West does not teach any specific method for securing the decorative part to the inlay area. Examiner would like to point out paragraphs [0033-0036] where not only does West give multiple ways to affix the precious metal component (the decorative portion) to the hard metal (main body, creating the inlay area), but he actually teaches of brazing, which is defined as the soldering of two metals together by using a hard solder with a high melting point. Further, regardless of whether or not West happened to teach of such a affixing method, the examiner takes official notice that it is old and well known, as well as extremely obvious, to use the art of soldering to attach two metals.

Examiner recommends focusing on the exact structure of the ring, as opposed to the composition of the materials that are subject to being put into such structure and the process of creating such a relationship between the different materials. The prior art is saturated with similar compositions and processes; the structural differences are what truly help define the inventions.

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Conclusion

[7] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

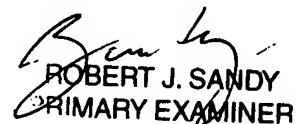
[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR


ROBERT J. SANDY
PRIMARY EXAMINER